

REMARKS

In the Official Action of June 16, 2006, the drawings were objected to, claims 1, 3, and 6 were provisionally rejected on double patenting grounds over claims 1-3, 12-13, 22-23, and 31-32 of co-pending application No. 09/672,162, and claims 1 and 3-6 were rejected under 35 U.S.C. 103 as being obvious over Patent No. 5,668,538 (Warwick) in view of Patent No. 5,608,655 (Moughanni). Applicants respectfully traverse these rejections, and in accordance with the requirements of 37 C.F.R. §§1.111(b) and 1.119, submit the following comments to distinctly and specifically point out the inappropriate nature of these rejections.

First with respect to the drawings, Applicant apologizes that this objection had to be repeated from the first (September 26, 2005) Action. A review of Applicant's file copy of the Response to Official Action of September 26, 2006 indicates that the proposed corrected drawings that were supposed to have been attached to that Response in accordance with the procedures set out in 37 C.F.R. 1.121(d) are missing, and therefore apparently were not included with that Response as filed. Applicant appreciates the tolerance for that oversight, and to respond to the objection at this time, Applicant attaches the same copies of page 1 of the drawings, on which Figs. 1 and 2 appear, and page 3 of the drawings, on which Fig. 4 appears, showing certain proposed changes (in red ink) that were supposed to have been attached to the Response to Official Action of September 26, 2006 for approval by the Examiner. As previously noted (in the Response to Official Action of September 26, 2006), the first proposed change appears on Fig. 2, which is labeled as "prior art." A review of the specification of the captioned application indicates that Fig. 2 is described as including components of the present invention. Because it shows components of the present invention, the words indicating that Fig. 2 is prior art have been struck through on the enclosed copy of page 1 of the drawings. In specific response to the objection to the drawings, the enclosed copy of page 3 of the drawings, on which Fig. 4 appears, is proposed to be amended by adding the word "paging" to the box near the top of the page that is labeled "transmitter." This proposed amendment to Fig. 3 does not add new matter since, as described on page 4, line 31 – page 5, line 5 of the specification, a paging transmitter is clearly described such that this proposed amendment to Fig. 3 simply conforms Fig. 3 to the disclosure in the specification. 37 C.F.R. 1.121(e). Again with apologies for the previous oversight, approval of these proposed amendments to Figs. 2 and 4 is respectfully requested.

In response to the provisional double patenting rejection over co-pending application Serial No. 09/672,162, Applicant has not responded to the most recent Office Action in Serial

No. 09/672,162 such that this provisional double patenting rejection will be rendered moot when Serial No. 09/672,162 is deemed abandoned for lack of response.

Turning now to the §103 rejection over the combination of Patent No. 5,668,538, Warwick, and Patent No. 5,608,655, Moughanni, as in Applicant's Response to Official Action of September 26, 2005, Applicant again respectfully submits that the Action fails to establish a proper *prima facie* showing of the obviousness of the differences between the claimed invention and the combination of the Warwick and Moughanni patents. The three criteria for establishing a *prima facie* case of obviousness are set out in MPEP §706.02(j) and in Applicant's Response to Official Action of September 26, 2005 and therefore will not be repeated here. Suffice to say that the Action does not provide a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings to make Applicant's claimed invention, fails to provide some expectation of success, and fails to establish that the cited prior art references teach or suggest all the claim limitations.

In Applicant's Response to Official Action of September 26, 2005, Applicant argued that neither Warwick nor Moughanni disclose a switching circuit that interrupts electrical power transmission in response to signals output from a processor as recited in the last paragraph of claim 1. The second (June 16, 2006) Official Action alleges (on page 6) that Warwick teaches a system for remote disconnection for electrical power meters having an input electrical supply source, an output electrical circuit, a switching circuit connected between input supply source and output circuit, and a processor for processing control signals from a receiver to open the switching circuit to interrupt electrical power transmission and that Moughanni teaches remote control of a paging system comprising a radio frequency receiver for receiving RF control signals from a paging transmitter. If it is assumed for the purposes of argument that Warwick and Moughanni do disclose all of these elements (and Applicant does not so admit), the two references still do not disclose a switching circuit **that interrupts electrical power transmission in response to signals from a processor**. Near the bottom of page 6 of the Action, it is alleged that Moughanni suggests the use of paging systems for remote control for turning off air conditioning or heaters, but Applicant's invention is not intended to, and is not claimed to, turn appliances on and off, and as noted in Applicant's Response to Official Action of September 26, 2005, for that reason, one cannot simply plug the Moughanni device into Warwick and expect to work in the manner claimed by Applicant to turn power transmission on and/or off. By the specific wording of Applicant's claim, electrical transmission is turned on

and/or off in response to RF signals that are received and processed “to open said switching circuit to interrupt electrical power transmission” (a difference that is highlighted by the amendment to the last word of claim 5 as set out above). Neither Warwick nor Moughanni teaches such structure. Consequently, and as previously noted by Applicant, the cited references do not disclose all of the elements of the claimed invention, alone or in combination. As required by MPEP §706.02(j), a showing that all the elements of the claimed invention are disclosed in the cited prior art must be made to establish a proper *prima facie* obviousness rejection, and in the absence of such a showing, a §103 rejection is improper and should be withdrawn.

Applicant’s Response to Official Action of September 26, 2005 also noted that neither reference provided a suggestion or motivation to modify the combined references in the manner claimed. Applicant noted in the Response to Official Action of September 26, 2005 that the only suggestion of such a motivation for making this combination that could be found in the September 26, 2005 Action were the allegations that Moughanni is “in the same field of endeavor [as Warwick] (remote control systems)” (repeated on page 3 and at the middle of page 6 of the June 16 Action) and “[o]bviously, these features [allegedly described in Moughanni] are beneficial in the system of Warwick since Warwick is concerned with controlling electricity meters remotely” (repeated on page 3 of the June 16 Action). Applicant argued that those allegations were inaccurate and that they were “generic” in the sense that they did not provide a **specific** motivation, disclosed in the prior art, for making the specific combination of prior art references asserted in the Action. Because they did not constitute a specific suggestion to modify the cited references, Applicant called upon the Examiner to make evidence of record (for instance, in the form of an affidavit as required by MPEP §2144.03) that such a modification and/or motivation was within the Examiner’s personal experience. *See In re Dembiczak* ((175 F.3d 994, 1000 (Fed. Cir. 1999) (the presence or absence of a motivation to combine references is a question of fact).

In response to Applicant’s arguments, the Official Action of June 16, 2006 does go further in trying to provide a suggestion, found in the art, to combine references. Specifically, the carry-over sentence on pages 3-4 alleges that

“[I]t would have been obvious to one of ordinary skill in the art, at the time of applicant’s invention, to include a paging device in the radio link of Warwick, because a pager device, as taught by Moughanni, provides an immediate link for controlling the electricity meters of Warwick at a distance away from his home.”

It is not clear what was intended by the phrase “immediate link” in this sentence, but aside from that question, the sentence begs the question: what is it about a radio link that would have made it obvious to include a paging device in Warwick for providing “an immediate link” for controlling electricity meters? Where is the motivation, in the art, for making this combination? If the phrase “immediate link” was intended to be an allegation that one could control electrical meters faster with an RF pager, doing something faster is not the kind of specific motivation to make the claimed combination required by applicable precedent. Nor can the requisite motivation be found in the allegation in the Action that Warwick and Moughanni are in the same field of endeavor, because they are not (see page 6 of Applicant’s Response to Official Action of September 26, 2005, noting that the two references do not both relate to remote control systems as alleged in both the first (September 26, 2005) and second (June 16, 2006) Actions). It is therefore submitted that Official Action of June 16, 2006 again fails to establish the requisite motivation or suggestion to combine Warwick and Moughanni in the manner asserted in the Official Action and Applicant again calls upon the Examiner to submit such evidence, in the form of a personal affidavit if need be, in support of the §103 rejection of independent claims 1 and 5.

Applicant’s Response Official Action of September 26, 2005 noted that the Official Action of September 26, 2005 failed to make the required showing of the third element of a *prima facie* obviousness rejection, namely, an expectation of success. In spite of that argument, Applicant is unable to find any indication anywhere in the Official Action of June 16, 2006 of any attempt to establish the required showing of an expectation of success. Consequently, it appears that the Official Action of June 16, 2006 fails to establish even one of the elements required to make out a proper *prima facie* showing of the obviousness of the differences between the invention claimed in claims 1 and 3-6 and the combination of the Warwick and Moughanni patents. In the absence of a showing of (1) all the claimed elements in the cited art, (2) a suggestion in the art to modify the combined references in the manner claimed, and (3) some expectation that such modification(s) can be made successfully, the §103 rejection is improper and should be withdrawn.

As set out in *In re Oetiker* (24 U.S.P.Q.2d 1443 (Fed. Cir. 1992))

“[a]fter evidence or argument is submitted by the applicant in response [to a *prima facie* rejection], patentability is determined on the totality of the record, by a preponderance of the evidence with due consideration to persuasiveness of argument.”

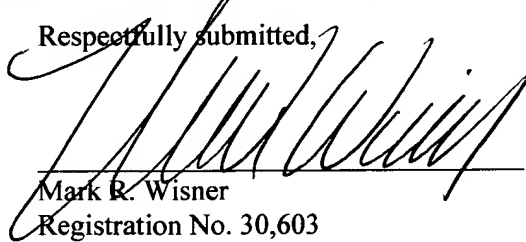
In responding to the first (September 26, 2006) Official Action in the captioned application, Applicant pointed out how the Office failed to establish a proper *prima facie* obviousness rejection, submitted arguments, and called for the submission of evidence to support the *prima facie* obviousness rejection. As set out in *Oetiker*,

“if examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent.”

Because the Office did not come forward with additional evidence to “re-establish” a *prima facie* showing of the unpatentability of claims 1 and 3-6 after Applicant rebutted the §103 rejection (made in the Official Action of September 26, 2005), “**without more**” Applicant is entitled to the grant of a patent.

Entry of the above amendments to the claims, consideration of the remarks set out herein, reconsideration and withdrawal of the rejections, allowance of the claims, and passage of the application to issuance are all respectfully requested. In the unforeseen event that there are questions and/or issues yet to be answered in this application, it is respectfully requested that Applicant’s Attorney be contacted at the address and phone number set out below.

Respectfully submitted,



Mark R. Wisner

Registration No. 30,603

1177 West Loop South, Suite 400

Houston, Texas 77027-9012

Telephone: (713) 785-0555

Facsimile: (713) 785-0561

ATTORNEY FOR APPLICANT(S)

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